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App. No: 10/518,110  
Docket No: EX03-039C-US

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of Canne, *et al.*  
Application No.: 10/518,110  
Filed: December 10, 2004  
For: HUMAN ADAM-10 INHIBITORS

Confirmation No.: 3309  
Attorney Docket No.: EX03-039C-US

**RENEWED REQUEST UNDER 37 CFR 1.497(d)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

This communication is in response to the Decision on request under 37 CFR 1.497(d), mailed October 3, 2005 (copy attached), dismissing applicants' petition to add Richard Khoury.

On page 2 of the communication, it was stated that 37 CFR 1.497(d)(3) was not satisfied, as the consent of the assignee was not supplied, and the assignment records were not provided. Further, it was stated that Office records indicated Exelixis assigning the interests in the application to SmithKlineBeecham.

In response to the above statements, Exelixis did provide consent of the assignee, Exelixis, on July 11, 2005, which was provided to the Office in the July 13, 2005 request, a copy of which is attached. Exelixis is the only assignee of record for the application. Assignment records were faxed into USPTO on May 9, 2005, a copy of which is attached. The assignment was recorded on May 9, 2005, and the recorded assignment resides at Reel/Frame 016208/0970. Regarding SmithKlineBeecham, Exelixis did not assign the right to the application. Rather, assigned security interest in the application to SmithKlineBeecham, a copy of which is attached. However, the security interest with respect to said application was also released, and a copy of the release is attached as well. Thus, Exelixis is the only assignee of record for this application. As such, the attached records satisfy the requirements of 37 CFR 1.497(d)(3).

On page 2 of the communication, submission of complete declaration was required. Attached is a copy of the original declaration, along with a complete copy of declaration by Zhaoyang Wen and Wei Xu.

It is believed that all issues regarding the petition under 37 CFR 1.497(d)(3) have been addressed. Applicants respectfully request reconsideration and entry of this petition.

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No fees are believed to be required for the submission of this request. However, if this belief is in error, the Commissioner is authorized to charge any fees for consideration of any papers filed herewith to deposit account no. 50-1108.

Respectfully submitted,

Dated: October 24, 2005



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In re Application of  
BANNEN, Lynne Canne et al.  
Application No.: 10/518,110  
PCT No.: PCT/US03/18262  
Int. Filing Date: 11 June 2003  
Priority Date: 12 June 2002<sup>03</sup>  
Attorney's Docket No.: EX02-039C-US  
For: HUMAN ADAM-10 INHIBITORS

## DECISION

### ON REQUEST UNDER

37 CFR 1.497(d)

This decision is in response to "Response to the Notification of Missing Requirements," filed on 15 July 2005. It has been treated as a request under 37 CFR 1.497(d).

## BACKGROUND

On 11 June 2003, applicant filed international application PCT/US03/18262, which claimed a priority date of 12 June 2002. The deadline for entry into the national stage in the United States was midnight on 12 December 2004.

On 10 December 2004, applicant filed a submission for entry into the national stage in the United States, accompanied by, *inter alia*, the U.S. Basic National Fee and a declaration of the inventors.

On 16 June 2005, the Office mailed Notification of Missing Requirements, indicating that the declaration listed an inventor not listed on the international application and requiring an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration.

On 15 July 2005, applicant filed the instant request.

## DISCUSSION

Applicants file this request to add Richard George Khoury as an inventor.

A request under 37 CFR 1.497(d) requires: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in § 1.17(i); and (3) the written consent of the assignee, if an original named inventor has executed an assignment.

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Items (1) and (2) have been satisfied. Applicants provided a statement by Richard George Khoury and the processing fee.

Item (3) has not been satisfied. Applicants must supply the consent of the assignee. Applicants have not satisfied 37 CFR 3.73(b). Applicants have not provided the assignment records, nor indicated where the assignment records can be located. Nonetheless, a check of Office records indicates that Exelixis assigned interests in this application to SmithKlineBeecham. If this is correct, the consent of SmithKlineBeecham is required. If there are any other assignees on this application, their consents are also required.

Additionally, the declaration does not comply with 37 CFR 1.497(a)-(b). Applicant has supplied one page 1, one pages 2 and additional inventor sheet. Applicants supplied one each of additional inventor sheets 1 of 4, 2 of 4 and 4 of 4, but three pages 3 of 4. The pages 3 of 4 list the same inventors, but were separately executed. While it is acceptable for inventors to execute different copies of the declaration, applicants must supply the full copy of the declaration executed by each inventor. Applicants may not piece together pages from different declarations to create a composite declaration. It appears there were at least three copies of the declaration executed. Applicants must supply complete declarations in compliance with 37 CFR 1.497(a)-(b).

### CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

A proper response including a declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration, must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)".

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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